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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,042	11/17/2000	Robert D. Briggs	PA000456	7621

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Patents Department
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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT PAPER NUMBER

2683

DATE MAILED: 05/12/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/716,042

Applicant(s)

BRIGGS ET AL.

Examiner

Stephen M. D'Agosta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-16, 20 and 29-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-16, 20, 29-43, 46, 47, 49-57 and 60-69 is/are rejected.
- 7) ☒ Claim(s) 44, 45, 48, 58 and 59 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 13.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 4-16, 20, 29-69 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claims 58-59 objected to because of the following informalities: they refer to "claim 0". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-16, 20 and 29-43, 46-47, 49-57 and 60-69 rejected under 35 U.S.C. 103(a) as being unpatentable over Jansen further in view of Reeder US 6,141,652, Rieken US 6,009,154 and Ronen US 5,845,267 (hereafter Reeder, Rieken and Ronen).

As per **claims 4, 29, 57, 60, 64**, Jansen teaches a method to invoice users (title is "pay-per use") for information accessed using a communication network comprising:

Placing a first location in communication with a remote second location (figures 1 and 2 show the Kiosk being connected to a remote computer/building)

Transferring information having at least one associated cost from second to first location, wherein transfer occurs prior to payment of the at least one associated cost being made for the information (figure 10, #254 shows payment method can be PRE-PAY, POST-PAY or FREE)

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Debiting the first location for the selected information after the information is transferred (figure 10, #300, 302, 304 and 306 calculating cost of the transfer and submitting usage record to database and receipt being printed, also C10, L23-32, specifically L28-32).

Recording associated costs at the first location and Communicating recorded costs from first location to an invoice location (figure 1 shows a Kiosk containing a computer processor, #14 which is further detailed in figure 4. Figure 2 shows a central server, #26 which is further detailed in figure 3. Both figures contain computers which are known in the art as being capable of recording/storing data on the processor and can communicate via comm. links shown in figure 1, #24/28. Figure 3 shows a database, #62 that contains billing records – these records can be recorded at either the Kiosk and/or at the central computer).

Communicating a debit charge from the second location to the invoicing location after the selected information is transferred (C3, L15-61, specifically L38 teaches a credit card reader to allow the user to be debited at the first location which is transferred through the central computer of figure 2 to a credit card company. One skilled in the art would provide for the debiting to be supported anywhere in the system).

Generating an invoice (figure 10, 300-306)

Communicating the invoice to a party responsible for satisfaction of the invoice (figure 10, #306 generates invoice/receipt for user at Kiosk)

But is silent on Comparing the recorded debits from the first location with the debits from the second location,

Rieken teaches flexible rate charging (figure 2) that involves negotiation between the user (eg. first location) and the service provider (eg. second location) for billing purposes. The examiner interprets this as reading on the claimed limitation of “comparing debits from first location with the debits from the second location”. In essence, this can be viewed as an error-checking function and/or a way of gaining agreement from both users/ends (ie. on the price to be charged, on the amount of data downloaded, etc.). Further to this point is Reeder who teaches a telecommunication system that connects two users at different sites together (figure 1 #110 connects to

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#30) and bills based on, among other things, the call record which inherently contains data regarding where each user is located (eg. is it a local or long distance call) [figure 1 shows billing station/center, #200 and C4, L44-53).

With further regard to claim 8, Jansen teaches the ability to view, download and print many different types of information (C1, L45-63, specifically L62-63) **but is silent on** and the ability to charge independently of the amount of time used. Ronen teaches billing based on a transaction and not amount of time (abstract and Column 6, Table2 shows a bill with a \$.50 charge to use the phone and \$25 to download software).

With further regard to claims 14 and 25, Jansen teaches a computer/DSP system with storage (Kiosk in figure 1 and #14 is a computer with storage that executes code/instructions) communicating all costs from the first location to an invoicing location, generating an invoice and communicating the invoice to a party responsible for the satisfaction of the invoice (figure 4 shows a credit card reader and printer to print invoice/receipt, and figure 10 shows pay-for-use service #304 and print receipt #306 which is for the user) **but is silent on** and charging a debit to the first location each instance the copy is used at the first location, independently of the amount of time used. Ronen teaches billing based on a transaction and not amount of time (abstract and Column 6, Table 2 shows a bill with a \$.50 charge to use the phone and \$25 to download software). One skilled understands that the first location would be billed for each instance the copy is downloaded/used at the first location.

With further regard to claim 30 and 67-69, Jansen teaches a computer system (figure 1 Kiosk and network shown in figure 2) embodying machine-readable instructions (figure 1, #14 is a computer executing code/instructions).

With further regard to claim 31, Jansen teaches vending "multimedia services" (abstract) which include voice, video and data and would inherently include providing software to the mobile user.

With further regard to claim 46, Jansen teaches an application program interface to download and execute software (abstract) since the invention allows a mobile phone user to interact (eg. via API) with a downloading system to receive multimedia files.

With further regard to claims 51/54, Jansen teaches a billing server/kiosk with memory and server code (eg. computer in Kiosk, see figure 1). Jansen's system inherently debits a user who interacts/downloads files over a wireless network and includes "information in the file (abstract) identifying files/software identification and debit amount. The examiner interprets Jansen's disclosure of a cost determiner as teaching an invoice being generated and generate a payment for the contributing party based on the debit information. The examiner notes that a software server can be substituted for a billing server.

It would have been obvious to one skilled in the art at the time of the invention to modify Jansen, such that checking/comparing is performed, to ensure that errors do not occur between the two end users/systems.

As per **claims 52-53**, Jansen teaches a server/kiosk as determining the debit (abstract) but the examiner notes that the mobile phone contains a processor and can perform some/all of the billing operations as performed by a billing server (eg. record number called, time of call, length of call, bytes transmitted, etc.).

As per **claim 5**, Jansen teaches claim 4 further comprising a mobile wireless communication device (C3, L35-38).

As per **claim 6**, Jansen teaches claim 5 further comprising connecting first and second locations via the Internet (figure 2, #40 shows connectivity to the Internet)

As per **claim 7**, Jansen teaches claim 6, comprising at least one cost for information access and one for each-use (title is "pay-per use", abstract, C2, L13-42).

As per **claim 9**, Jansen teaches claim 1 further comprising:

Recording associated costs at the first location

Communicating recorded costs from first location to an invoice location (figure 1 shows a Kiosk containing a computer processor, #14 which is further detailed in figure 4. Figure 2 shows a central server, #26 which is further detailed in figure 3. Both figures contain computers which are known in the art as being capable of recording/storing data on the processor and can communicate via comm. links shown in figure 1, #24/28. Figure 3 shows a database, #62 that contains billing records – these records can be recorded at either the Kiosk and/or at the central computer).

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As per **claim 10**, Jansen teaches claim 9 further comprising communicating a debit charge from the second location to the invoicing location after the selected information is transferred (C3, L15-61, specifically L38 teaches a credit card reader to allow the user to be debited at the first location which is transferred through the central computer of figure 2 to a credit card company. One skilled in the art would provide for the debiting to be supported anywhere in the system).

As per **claim 11**, Jansen teaches claim 10, further comprising a mobile wireless communication device (C3, L35-38).

As per **claim 12**, Jansen teaches claim 11, further comprising connecting first and second locations via the Internet (figure 2, #40 shows connectivity to the Internet)

As per **claim 13**, Jansen teaches claim 12 wherein the selected information is an application program (abstract teaches receiving a "file" and C1, L62 teaches Internet access which can provide download of programs via FTP, etc.). The examiner interprets any download of generic files as reading on an application program download as well.

As per **claim 15**, Jansen teaches claim 14 wherein the another at least one associated cost is zero, wherein the copy of the designated information has an each-use associated cost, and wherein the each-use associated cost is incurred each time the designated information is used (abstract teaches "cost-per-unit-time" and a usage cost based on "time" and "information in file").

As per **claim 16**, Jansen teaches claim 15 wherein the copy of the designated information is used at the first location (figure 1 shows data downloaded to Kiosk).

As per **claim 32**, Jansen teaches claim 31 wherein the debit is based on usage of the software after expiration of a usage period (abstract teaches "cost per unit time" and usage cost determiner for determining usage cost based – eg. based on start/stop time).

As per **claims 33-36**, Jansen teaches claim 31 wherein the debit is based on either detecting execution of the software, multiple executions and/or downloading or not downloading of software (Abstract).

Since Jansen teaches tracking/recording downloading of multimedia services to a phone, this inherently requires the system to understand what has been downloaded

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(or not) and what has been executed once or many times – eg. the data can be costed as if a user downloads the data, it is assumed that it is run once and costed for one execution. Downloading a second time requires a second charge, etc.

As per **claims 37-43**, Jansen teaches claim 31 **but is silent on** wherein the debit is generated at the mobile, transmitted to the billing server, transmitted during off-peak period, generated remotely from the mobile, resource center is located remotely from billing server, billing server is located at wireless provider and resource center is located remotely from wireless service provider and/or billing server is located at a wireless service provider and the resource center is located across a plurality of software supplier servers.

Reeder teaches connecting a user to a program downloading source station(s) (figure 1, #110 connects to #30) and a billing station correlates billing information (#200) which is located remotely from the PSTN and/or MSC if mobile/cellular system. The examiner notes that either the billing station or the mobile can determine billing since both have processing capability and can record length of call and bytes transmitted. Lastly, the download stations can be either one central site or distributed across many different sites.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Jansen, such that the debit is generated at the mobile, transmitted to the billing server, transmitted during off-peak period, generated remotely from the mobile, resource center is located remotely from billing server, billing server is located at wireless provider and resource center is located remotely from wireless service provider and/or billing server is located at a wireless service provider and the resource center is located across a plurality of software supplier servers, to provide means for a flexible solution for user/server-centric billing for data downloads to a mobile device.

As per **claim 47**, Jansen teaches claim 46 wherein the interaction includes the use of the downloaded application and/or access to the downloaded application software (Abstract teaches downloading, eg. for using/execution, of multimedia files which include data files that can be applications).

As per **claim 49**, Jansen teaches claim 46 further comprising a timer wherein the API interface is operable to interact with the timer to transmit debit over a wireless network during off-peak periods of the wireless network (abstract teaches cost per unit time and determination of cost after a call/download is completed. The examiner notes that sending "data" at off-peak hours is known in the art and typically occurs at night when traffic is low (eg. perform company backups across LAN/WAN links when employees are home – one skilled would adapt this to have all download costs transmitted to a billing server at night so that costs are posted the next morning).

As per **claim 50**, Jansen is silent on a counter operable to count the number of interactions between the wireless device and the downloaded application software wherein the debit is generated only after the counter reaches a certain value.

The examiner notes that "counters" are well known in the art and provide for identifying if/when a number of events have occurred whereby a process is spawned. Jansen teaches a usage cost determiner that determines a cost based on a time of use of service and information in the file (abstract) – one skilled can adapt the "cost determiner" to also count how many times a certain file was accessed, downloaded, executed, etc..

As per **claims 55-56**, Jansen teaches a software download that can include clip-art, files, data, application programs, and multimedia (abstract teaches multimedia).

As per **claims 61-62**, Jansen teaches claim 60 comprising generating a payment for the contributing party based on debit information and wherein the debit is received from the wireless mobile device (abstract teaches determining cost of usage to pay a debit incurred by the mobile user).

As per **claim 63**, Jansen teaches claim 60 but is silent on wherein the debit is received from a remote server.

Reeder teaches connecting a user to a program downloading source station(s) (figure 1, #110 connects to #30) and a billing station correlates billing information (#200) which is located remotely from the PSTN and/or MSC if mobile/cellular system. The examiner notes that either the billing station or the mobile can determine billing since both have processing capability and can record length of call and bytes transmitted.

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Lastly, the download stations can be either one central site or distributed across many different sites.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Jansen, such that the debit is received from a remote server, to provide means for supporting a design with a distributed billing system rather than a central billing system (which is a single point of failure).

As per claims 65-66, Jansen teaches a software download that can include clip-art, files, data, application programs, and multimedia (abstract teaches multimedia).

Allowable Subject Matter

Claims 44-45 and 48 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

These claims recite highly specific limitations not found in prior art cited.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
5-7-04

